Sughrue
SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213
T 202.293.7060
F 202.293.7860
www.sughrue.com

FAX

Date	August 16, 2005		
To	Examiner Vickie Y. Kim		
Of	PTO Group Art Unit 1614		
Fax	571-273-8300		
From	Jennifer M. Hayes		
Subject	Request to Withdraw Finality of Office Action		
Our Ref	Q54487	Appln No	09/492,763
Conf No	1343	Inventors	Eiko MASATSUJI, et al.
Pages	6 (including cover sheet)		

Please call attention to problems with this transmission by return fax or telephone. Thank you.

This fax filing includes:
1. This cover sheet; and
2. Request to Withdraw Finality of Office Action

CERTIFICATION OF FACSIMILE TRANSMISSION

Sir:

I hereby certify that the above identified correspondence is being facsimile transmitted to Examiner Vickie Y. Kim at the Patent and Trademark Office on August 16, 2005 at 571-273-8300.

Respectfully submitted,

Jennifer M. Hayes

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AUG 16 2005

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Eiko MASATSUJI, et al.

Docket No: Q54487

Appln. No.: 09/492,763

Group Art Unit: 1614

Confirmation No.: 1343

Examiner: Vickie Y. Kim

Filed: January 27, 2000

For: DERMAL AGENT

REQUEST TO WITHDRAW FINALITY OF OFFICE ACTION

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A final Office Action was issued on June 16, 2005, in the above-identified application.

Applicants respectfully request the Examiner to withdraw the finality of the Office Action for the reason that Applicants' Response under 37 C.F.R. § 1.111 filed April 28, 2004, in reply to the Office Action dated January 28, 2004, did not necessitate the new grounds of rejection.

In the Office Action dated June 16, 2005, the Examiner contends that the new grounds of rejection were necessitated by Applicants' amendment. However, no amendments were made in the Response filed on April 28, 2004. Therefore, in view of the above, Applicants respectfully submit that the Office Action dated June 16, 2005, was improperly made final in view of the new grounds for rejection which were not necessitated by amendments made by Applicants.

Applicants' Response to the Office Action dated January 28, 2004, included a Declaration under 37 C.F.R. § 1.132. The Declaration under 37 C.F.R. § 1.132 was submitted to establish that the subject matter in the Suzuki et al reference upon which the Examiner relied was attributable to the present applicants and not the invention of another. No amendments to the claims were made in the Response filed on April 28, 2004.

In the Office Action dated June 16, 2005, the Examiner rejects claims 1-6 under 35 U.S.C. § 102/103 over Sano et al or alternatively over Sano in view of Fahim. This rejection was raised in the Office Action dated May 16, 2003, essentially for the same reasons. Applicants traversed this rejection in the Response filed on September 16, 2003, for the reasons set forth therein and the rejection was not repeated in the subsequent Office Action mailed on January 28, 2004. Therefore the rejection is considered as being withdrawn. In the Office Action dated June 16, 2005, the Examiner states that the arguments submitted in the Response filed on September 16, 2003, are not found to be persuasive and repeats the previously withdrawn rejection. Therefore, since the rejection was previously withdrawn, this is a new grounds for rejection.

MPEP § 706.07(a) which states that a second or any subsequent action on the merits shall be final, **except** where the Examiner introduces a new ground for rejection that is: (1) not necessitated by an applicant's amendment of the claims or (2) based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c). In this case Applicants have not made any amendments to the claims nor is the Examiner's rejection based upon any information submitted in the Information Disclosure Statements filed within the period set forth above. Thus, the Response filed on September 16, 2003, cannot

serve as the basis for new grounds of rejection. Therefore the Examiner's imposition of a final rejection where new rejections are made in the absence of amendments to the claims by Applicants is improper.

Applicants further submit that the Examiner did not properly consider the Declaration under 37 C.F.R. § 1.132 filed with the Response on April 28, 2004 (the executed version was filed on July 12, 2004). In the Office Action dated June 16, 2005, the Examiner indicates that a Declaration under 37 C.F.R. § 1.132 is improper and a Declaration under 37 C.F.R. § 1.131 with "proper documents (e.g., lab note, etc.)" to prove Applicants' own work that is earlier than the prior art is necessary to antedate the reference. This is incorrect. Applicants' Declaration under 37 C.F.R. § 1.132 filed on April 28, 2004 (followed by the executed version on July 12, 2004), was submitted to establish that the disclosure in the reference on which the Examiner relies is not the invention of another and was not submitted for the purpose of antedating the reference. Since the reference, EP '321, only qualifies as a reference under 35 U.S.C. § 102(a), a Declaration under 37 C.F.R. § 1.132 establishing that the subject matter upon which the Examiner relies was derived from the Applicants and therefore is not the invention of another is proper. There is no requirement for lab notebooks, etc. See MPEP § 2132.01 and the Katz case cited therein. Thus, Applicants respectfully submit that since the Examiner did not properly consider the Declaration and address the Declaration on the merits, such is another reason why it is not proper for the Examiner to make the Office Action final.

Further, Applicants respectfully submit that the imposition of a final rejection under these circumstances is unfair to Applicants and against public policy. Applicants should be

given a fair opportunity to define his or her invention in claims that will give patent protection to which the applicant is entitled and not be prematurely cut off in the prosecution of the application. MPEP § 706.07. Specifically, the MPEP states:

> The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible before appeal.

In this regard, if a final rejection is appropriate, the Office Action should properly address all evidence submitted on the merits and the Examiner should present the best case with all the relevant reasons, issues, and evidence so that all such rejections can be withdrawn if applicant provides appropriate convincing arguments and/or evidence in rebuttal. In this case, the Examiner has not properly addressed the evidence submitted in the Declaration under 37 C.F.R. § 1.132 on the merits of the basis for which it was presented, thereby prematurely cutting off prosecution of the application.

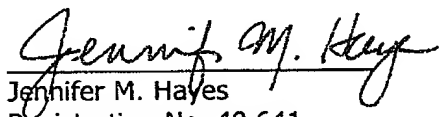
In addition, to meet the goal of reaching a clearly defined issue for an early termination of proceedings, i.e., an allowance or final rejection, the Examiner is charged with conducting a careful and thorough search and fully applying the references in preparing the first Office Action on the merits in order for a speedy and just determination of the issues involved in the examination of the application. See MPEP §§ 706.07 and 904.03. The Examiner has not met this goal in repeating a rejection that was withdrawn in view of arguments that were considered to be sufficiently persuasive, particularly wherein the claims are not further amended and maintain the same scope.

Request for Withdrawal of Finality of Office Action
U.S. App. Ser. No. 09/492,763

Atty Dckt. No. Q54487

Accordingly, Applicants respectfully request withdrawal of the finality of the Office Action dated June 16, 2005 and issuance of a new Office Action properly addressing the Declaration under 37 C.F.R. § 1.132 and all arguments and evidence of record.

Respectfully submitted,



Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: August 16, 2005

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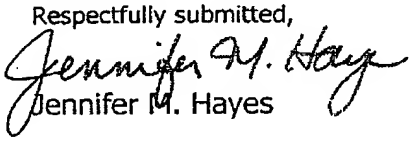

Jennifer M. Hayes